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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,672	01/14/2004	Stuart A. Green	286674.127US1 (HH/AVK/P10)	8056
23483	7590	07/10/2007	EXAMINER	
WILMER CUTLER PICKERING HALE AND DORR LLP 60 STATE STREET BOSTON, MA 02109			SHIBRU, HELEN	
			ART UNIT	PAPER NUMBER
			2621	
			NOTIFICATION DATE	DELIVERY MODE
			07/10/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/757,672	GREEN, STUART A.	
	Examiner	Art Unit	
	HELEN SHIBRU	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-78 is/are pending in the application.
- 4a) Of the above claim(s) 72-76 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 35-39, 48, 58-62 and 71 is/are rejected.
- 7) ☒ Claim(s) 7-34, 40-47, 49-57, 63-70, 77 and 78 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07/05/2005</u> | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-6, 35-39, 48, 58-62 and 71 are rejected under 35 U.S.C. 102(b) as being anticipated by Okada (EP 0 994 480 A1).

Regarding claim 1, Okada discloses an authoring method for use in creating an audiovisual product, comprising the steps of: defining a plurality of components, the components implicitly representing functional sections of audiovisual content with respect to one or more raw content objects, and a plurality of transitions that represent movements between the plurality of components (see figs 9A and 17 and paragraphs 0057-0059); expanding the plurality of components and the plurality of transitions to provide a set of explicitly realised AV assets (set of scrolling image data) and an expanded intermediate data structure of nodes and links (links to the set of scrolling image data and to images of each scrolling set--that is the video sequences within each set showing the scrolling), where each node is associated with an AV asset of the set and the links represent movement from one node to another (paragraphs 0068-0113); creating an audiovisual product in a predetermined output format, using the AV assets and the expanded intermediate data structure of the nodes and the links; and testing the audiovisual product (see paragraphs 0113-0123).

Regarding claim 2, Okada discloses the defining step comprises defining at least one information component that comprises a reference to a raw content object (see paragraphs 0060-0067).

Regarding claim 3, Okada discloses the reference denotes a file path to a location where the raw content object is stored (see fig. 17).

Regarding claim 4, Okada discloses the defining step comprises defining at least one choice component comprising a reference to at least one raw content object, and at least one authoring parameter (see fig. 12 and paragraphs 0080-0084).

Regarding claim 5, Okada discloses the at least one authoring parameter is adapted to control a selection or modification of the at least one raw content object (see paragraphs 0064-0065).

Regarding claim 6, Okada discloses the at least one authoring parameter comprises a runtime variable available during playback of the audiovisual product (see paragraphs 0124-0127).

Claim 35 is rejected for the same reason as discussed in claim 1 above.

Claims 36-37 are rejected for the same reason as discussed in claims 2 and 4 respectively above.

Regarding claim 38, Okada discloses the choice component comprises a reference to a presentation template and a reference to at least one item of substitutable content to be placed in the template according to the at least one parameter (see figs 10-12).

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Regarding claim 39, Okada discloses the choice component comprises at least one runtime variable available during playback of an audiovisual product in a DVD player, and at least one authoring parameter not available during playback (see paragraphs 0147-0149).

Regarding claim 48, the limitation of claim 48 can be found in claim 1. Therefore claim 48 is analyzed and rejected for the same reason as discussed in claim 1 above. See also paragraphs 0147-010151.

Regarding claim 58, Okada discloses A data processing system for authoring optical medium data comprising: means for producing, from data representing a static visual asset, a set of visual assets in which each visual asset of the set comprises data unique to that asset and data common to that asset and at least one other visual asset of the set; each visual asset of the set having respective defined dimensions (see figs. 10-14).

Regarding claim 59, Okada discloses the means for producing the set of visual assets comprises means for progressively traversing the static visual asset to copy data, from the static visual asset, to form respective visual assets of the set (see paragraphs 0060-0067).

Regarding claim 60, Okada discloses the means for traversing comprises means for defining a predeterminable step size, less than at least one of the respective defined dimensions, and traversing the static visual asset according to that predeterminable step size (see paragraphs 0099-0110).

Regarding claim 61, Okada discloses means for creating, for each visual asset in the set, associated asset display control data comprising data representing at least one selectable graphical element and at least one link, associated with the selectable graphical element, to another visual asset of the set of visual assets (see paragraphs 0120-1023).

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Regarding claim 62, Okada discloses means for creating comprises: means for creating, for selected or all visual assets of the set of visual assets, associated asset display control data comprising data representing at least a pair of selectable graphical elements and data representing at least a pair of links, associated with respective ones of the pair of selectable graphical elements, to a preceding visual asset and a succeeding visual asset of the set of visual assets (see paragraphs 0128-0133).

Regarding claim 71, Okada discloses a DVD product comprising data representing a set of visual assets, the visual assets having been derived from a static visual asset such that at least a pair of successive visual assets of the set of visual assets comprise respective unique data and data common to the pair of successive visual assets thereby allowing a scrolling effect to be emulated when the pair of assets are successively displayed (see paragraphs 0147-0157 and figs. 18-19).

Claim Objections

3. Claims 7-34, 40-47, 49-57, 63-70, and 77-78 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claims cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

Double Patenting

4. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

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A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

5. Claims 1-6, 35-39, and 48, provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-6, 35-39, and 48 respectively of copending Application No. 10/757191. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 72-76 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Therefore the claims are withdrawn from further consideration.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HELEN SHIBRU whose telephone number is (571) 272-7329.


The examiner can normally be reached on M-F, 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THAI Q. TRAN can be reached on (571) 272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Helen Shibru
June 21, 2007



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